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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,280	07/31/2003	Roger F. Fox	025374.018	3771

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EXAMINER

BAREFORD, KATHERINE A

ART UNIT PAPER NUMBER

1762

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/631,280

Applicant(s)

FOX ET AL.

Examiner

Katherine A. Bareford

Art Unit

1762

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-17.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached pages.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: note attached Interview Summary PTOL-413.

*Advisory Action*

1. Continuation of Box 4 and Box 7:

For purposes of appeal, the proposed amendments will not be entered because the proposed amendments are in non-compliant form as discussed below and on the attached PTOL-324.

Specifically, (1) as to the amendments to the drawings, the amended sheets are not labeled "Replacement Sheet" or "New Sheet" as is required by 37 CFR 1.121(d).

(2) As to the amendments to the specification, it is not clear from the filing what form of amendment was intended, but the resulting filing is non-compliant. (A) If ✓/s applicant is attempting to amend ~~the~~ the specification by the amendments provided on page 2 of the amendment in the section labeled, "Amendments to the Specification", then the amendments are non-compliant because the attempt to change the number of Figures 1-4 on page 5 is not provided with the proper paragraphs and markings, and the attempts to delete the graphs, tables and photos and provide replacement material is improper as the proper paragraphs and markings have not been provided.

Furthermore, the specification has not be provided with the further corrective material from the replacements and deletions, such as removing references to graphs and replacing with references to figures, and renumbering references to referred to Tables that have been renumbered. As well, no specific references to the new drawings have been provided in the Detailed Description. Furthermore, it would be unclear why a partially amended copy of the specification, claims and abstract was filed. (B) If

applicant is attempting to provide a substitute specification to amend the specification, then this attempt is also non-compliant. With the August 29, 2005 amendment, applicant filed a copy of the specification that had the graphs and photo removed and Tables renumbered. However, applicant provided no indication that this is intended to be a substitute specification. The copy was not labeled as such and nothing in applicants Remarks indicates a substitute specification. Moreover, the substitute specification would be in improper form as the amendments to page 5 are not provided, and the amendments from the January 19, 2005 amendment are not provided in the specification. As well, the specification has not be provided with the further corrective material from the replacements and deletions, such as removing references to graphs and replacing with references to figures, and renumbering references to referred to Tables that have been renumbered. Furthermore, no marked up copy of the specification was provided.

2. Continuation of Box 11

The request for reconsideration has been considered but does not place the application in condition for allowance because:

(1) the proposed amendments have not been entered as discussed in the paragraph 1 above. As a result, no claims are canceled, and the outstanding rejections remain for the reasons given in the Final Rejection.

(2) as to applicant's arguments as to the outstanding new matter rejections:

ms a) as to the amount of carbon dioxide in relation to "wood protectant fluid" as to the Examiner indicating that there is no indication that the protection is in the form of a fluid, applicant argues that page 30, line 7 of the application as filed states that the "fluid is a wood protectant" and in addition the examples use an aqueous based amine solution. The Examiner has reviewed these arguments, and accepts the argument that the protectant would be in the form of a fluid. The Examiner does note that the specification has no page 30 (it would be the first page of claims). At page 29, lines 7-8, the specification states "wherein the fluid is a wood protectant with carbon dioxide added thereto". The Examiner does find support <sup>there.</sup> ~~for the~~ <sub>^</sub>

b) as to the mole ratio: applicant argues that this range is derived from the examples, providing a calculation that the resulting mole ratio is 1:0.08—1:0.8. The Examiner has reviewed these arguments, however, the rejection is maintained. The added and claimed range is 1:0.05 to 1:0.5, which is a broader range than the calculated range above.

c) as to the pH: applicant argues the amended pH of about 9.5 to about 9.6. However, this is the pH as proposed to be amended, and as the amendment is not entered, the pH is not changed to this range. However, the Examiner does see support in the specification for the pH of 9.6 and 9.5 as described.

d) as to the rejection of claim 8: the Examiner has reviewed page 7, lines 6-10 but there is no indication that the claimed materials would be impregnated at the time of the wood protectant impregnation.

e) as to the rejection of claims 10-11: the Examiner accepts applicant's arguments.


f) as to the rejection of claims 12-13: this rejection is maintained for the reasons given as to b) above.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (571) 272-1413. The examiner can normally be reached on M-F(6:00-3:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and for After Final communications.

Other inquiries can be directed to the Tech Center 1700 telephone number at (571) 272-1700.

Furthermore, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**KATHERINE BAREFORD**  
**PRIMARY EXAMINER**